

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 2

REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application, and respectfully requests reconsideration and allowance in view of the following remarks.

Claims 1, 3-11, 21-26, and 28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,032 (Bateman et al.) in view of U.S. Patent No. 4,052,570 (Sutton). Applicant respectfully traverses this rejection.

Claim 21 is dependent upon independent claim 13 and claims 23-26 and 28 are dependent upon independent claim 22. Independent claims 13 and 22 both recite "a predictive dialer." Applicant submits that the neither Bateman et al. nor Sutton, alone or in combination, disclose or suggest the use of a predictive dialer. See Present Office Action, paragraph 3, "What Bateman et al. and Sutton do not teach is a predictive dialer". Accordingly, Applicant submits that the rejection of claims 21-26 and 28 is improper and should be withdrawn.

Moreover, Applicant respectfully submits that it is improper to combine Sutton with any other reference because Sutton is not analogous art. To be considered analogous art, a "two-step test" must be satisfied. First, the reference must be "within the field

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 3

of the inventor's endeavor." Second, assuming the reference is outside that field, the reference must be "reasonably pertinent to the particular problem with which the inventor was involved."

In *In re Clay* (1992), the Federal Circuit held that the PTO committed clear error in finding a cited reference to be analogous art that could be combined with other references to determine the patentability of an applicant's claims. The applicant disclosed and claimed "a process for storing refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet port." "The process involves preparing a gelation solution which gels after it is placed in the tank's dead volume; the gel can easily be removed by adding to the tank a gel-degrading agent such as hydrogen peroxide." The PTO rejected the applicant's claims as obvious in view of two references: (i) Hetherington, which disclosed "an apparatus for displacing dead space liquid using impervious bladders, or large bags, formed with flexible membranes"; and (ii) Sydansk, which disclosed "a process for reducing the permeability of hydrocarbon-bearing formations and thus improving oil production, using a gel similar to that in [applicant's] invention." The Board found Sydansk "to be within the field of Clay's endeavor because ... one of ordinary skill in

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 4

the art would certainly glean from [Sydansk] that the rigid gel as taught therein would have a number of applications within the manipulation of the storage and processing of hydrocarbon liquids ... [and that] the gel as taught in Sydansk would be expected to function in a similar manner as the bladders in the Hetherington patent."

Reversing, the Court applied the "two part" test and held that the cited reference was not in the inventor's "field of endeavor":

[The reference] cannot be considered to be within [the inventor's] field of endeavor merely because both relate to the petroleum industry. [The reference] teaches the use of a gel in unconfined and irregular volumes within generally underground natural oilbearing formations to channel flow in a desired direction; [the inventor] teaches the introduction of gel to the confined dead volume of a man-made storage tank. The [reference] process operates in extreme conditions, with petroleum formation temperatures as high as 115 degrees C and at significant well bore pressures; [the inventor's] process apparently operates at ambient temperature and atmospheric pressure. [The inventor's] field of endeavor is the storage of refined liquid hydrocarbons. The field of endeavor of [the reference] invention, on the other hand, is the extraction of crude petroleum.

Next, the Court held that the cited reference is not reasonably pertinent to the inventor's problem:

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals,

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 5

logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

Applicant respectfully submits that the present application is similar to *In re Clay* and that Sutton is neither "within the field of the inventor's endeavor" nor "reasonably pertinent to the particular problem with which the inventor was involved." The present invention is directed to, for example, a system for a call center that provides an automatic telephone call back in response to a request transmitted over a data path and includes a data path interface and an automated dialer system.

In contrast, Sutton is directed to a telephone set that automatically redials a telephone number after a busy signal has been received once a user has previously dialed the telephone number. The telephone set includes a control circuit, responsive to both the detection of a busy signal and the releasing of the telephone line, which waits a predetermined fixed amount of time

In re: Malcom B. Strandberg

Filed: September 28, 1998

Serial No.: 09/161,816

Page 6

subsequent to which it seizes the line and causes the number stored to be redialed.

Sutton's field of endeavor includes telephone sets for making outbound calls only. While both Sutton and the present invention use telephony in a general sense, these are two very distinct areas much like the Court in *In re Clay* held that extracting petroleum from the ground using a gel and from a tank using gel are two different fields of endeavor even though both dealt with the petroleum industry. Applicant submits that it is improper to simply lump Sutton and the present invention in the same field of endeavor simply because they both deal with "telephony" in a general and broad manner.

Furthermore, the problem that Sutton addresses is to provide a telephone set that automatically redials a telephone number previously dialed by a human operator in response to a receiving a busy signal. See *Sutton, Abstract and Summary of the Invention*. Applicant submits that one skilled in the art looking to solve the problem of receiving and handling call-back requests in a call center would not look to solve the problem by looking at telephone sets which are capable of only making outbound calls and then only merely re-dialing a previously dialed telephone number.

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 7

Accordingly, Applicant submits that the combination of Sutton with the other cited references is improper and requests that the rejection of the pending claims should be withdrawn.

Claims 12-20 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,032 (Bateman et al.) in view of U.S. Patent No. 4,052,570 (Sutton) and further in view of U.S. Patent No. 5,214,688 (Szlam et al.). Applicant respectfully traverses this rejection.

In addition to the arguments discussed above, Applicant additionally submits that the combination of Bateman et al. and Szlam et al. is improper because there is no motivation to combine the references. The Examiner has explicitly acknowledged that Bateman et al. make no reference whatsoever to a predictive dialer, but argues that it would have been obvious for one of ordinary skill in the art to combine the teachings of Bateman et al. with those of Szlam et al. Nevertheless, the Examiner simply states that there is motivation to combine the references because both deal, generally, with call centers.

Applicant submits that it is improper for the Examiner to state that there is motivation to combine Bateman et al. and Sutton et al. simply because the two references deal, generally,

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 8

with call centers. While, there may be some overlap between the users of the technology of Bateman et al. and Szlam et al., the technology and algorithms used in predictive dialing applications have no connection to the technology of Bateman et al. and the present invention which involve primarily networking and internetworking. The fact that the lengthy specifications of both Bateman et al. and Szlam et al. make no reference to the other's technology or applications is indicative of the disparateness of the subject matter.

MPEP § 2143.01 states, in relevant part, that the Examiner must show WHERE in the prior art can be found a "clear suggestion" that the claimed combination is obvious. This requirement is in addition to the requirement that the references must be analogous art. Applicant submits that the Examiner has failed to show where in the prior art there can be found a "clear suggestion" that the claimed combination is obvious.

In *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16 USPQ 2d 1923 (Fed. Cir. 1990) the appellant argued that the district court misapplied the Section 103 nonobviousness standard "by adopting an overly stringent test" that required "that the claimed combination be "clearly suggested" by the prior art in

In re: Malcom B. Strandberg
Filed: September 28, 1998
Serial No.: 09/161,816
Page 9

order to be obvious." 16 USPQ2d at 1926.

The Federal Circuit found no reversible error stating:

"[In] *Kimberly-Clark [Corp. v. Johnson & Johnson]*, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984)], not only did we "fail to find a clear suggestion of the claimed subject matter," ... we found "not the slightest suggestion" in the art of the claimed dual function adhesive....

As to whether "clear suggestion" is a proper test of obviousness, we note initially that *Kimberly-Clark* is not the only instance in which we have made use of that phrase in a discussion of obviousness. Various other formulations of the requisite level of suggestion for combining prior art disclosures have been set forth in our precedent.

We need not decide here whether "clear suggestion" is an overly rigorous test for obviousness, however... . [T]his court independently reviews obviousness determinations. In reaching our own conclusion regarding obviousness, we need not give deference to a particular analytical construct utilized in a district court's opinion. Our task is to review the district court's judgment." 16 USPQ2d at 1926-27.

In *In re Oetiker* 24 USPQ2d 1443 (Fed. Cir. 1992), the court reiterated that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not come from the applicant's invention itself." 24 USPQ2d at 1446

Accordingly, since the Examiner has failed to state a *prima facie* case of obviousness of the pending claims and has failed to show a "clear suggestion" in the prior art itself for combining

In re: Malcom B. Strandberg

Filed: September 28, 1998

Serial No.: 09/161,816

Page 10

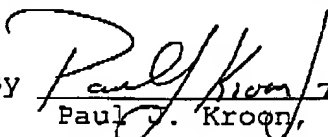
the art to render obvious applicant's claimed combination, Applicant submits that the rejection of the pending claims is improper and should be withdrawn.

For the foregoing reasons, Applicant respectfully submits that the rejections of the pending claims are improper and should be withdrawn. The examiner is invited to telephone the undersigned, Applicant's Attorney of Record, to facilitate advancement of the present application.

Respectfully submitted,

Malcom B. Strandberg

By


Paul J. Kroon, Jr., Esq.
Registration No. 51,902
Attorney for Applicant(s)

BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104

Telephone: (603) 623-5111
Facsimile: (603) 624-1432

Date:

August 19, 2003

OFFICIAL

FAX RECEIVED

AUG 20 2003

GROUP 2600